

Application No.: 09/843,148**Docket No.: 1509-174****REMARKS**

Applicants note the indication of claim 11 having allowable subject matter.

Claims 11, 12, 14 and 21 have been amended to obviate the objection to them. Apparently the objection to "and, Configuration" was directed to claim 14 since the "and, Configuration" terminology was not in claim 12 but is in claim 14. Other changes have been made for syntax to assure open ended coverage and prevent interpretation under 35 U.S.C. 112, 6th paragraph.

The amendment to claim 21 of the present response obviates the double patenting rejection because the claims of Serial Number 09/842,872 do not require "storing as a back up a known good pristine copy of said primary system on a third said partition area." The foregoing limitation is in the sentence bridging pages 14 and 15 of the application as filed.

Claim 14 has been amended for clarity and claim 21 has been amended to include the limitation recited in the previous paragraph.

Applicants traverse the anticipation rejection of claims 1, 2, 8-10, 12-14 and 17-19 based on McGill III et al (US 5,469,573). Claim 1 requires rebuilding a primary operating system from a copy of the primary operating system in an as manufactured state that is stored on a data storage device. Claim 14 requires a data storage device to include a copy of a primary operating system in an as manufactured state. The data storage device of claim 14 also includes a primary operating system for running a computer entity and a secondary operating system for rebuilding the primary operating system during a failure of the primary system.

Applicants fail to see where McGill III et al discloses the foregoing limitations concerning a primary operating system in an as manufactured state. The portion of McGill III et al recited in the office action for this feature does not disclose it. If the Examiner is relying on inherency for the

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foregoing feature, he has not met the burden of proving inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F3d 1531, 1534, 28 USPQ 1955, 1957 (Federal Circuit 1993); in Re Oelrich, 666 F2d 578, 58, 582, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by probabilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Roberston 169 F3d 743, 745, 49 UDSPQ 2nd 1949, 1950-1951 (Federal Circuit 1999). In relying upon a theory of inherency, the examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. Ex parte Levy, USPQ 2nd 1461, 1464 (Board of Patent Appeals and Interferences 1990). Based on the foregoing the Examiner must present rationale and/or evidence to indicate McGill, III inherently includes a primary operating system in an as manufactured state.

Claims 2, 8-10, 12, 13 and 17-19 are patentable for the same reasons advanced for claims 1 and 14 upon which they depend.

Claim 21, as amended, distinguishes over McGill III et al by requiring the limitation discussed in overcoming the double patenting rejection. The feature is similar to the discussed distinguishing feature of claims 1 and 14 and is not disclosed in McGill III et al.

The rejection of claims 3-7, 15, 16, 20, 22 and 23 as being obvious over McGill III et al is incorrect because these claims depend on claims 1, 14 and 21, that are improperly rejected on McGill III et al., as discussed supra.

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In view of the foregoing amendments and remarks, allowance is in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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